

No. 11,991

IN THE

# United States Court of Appeals

FOR THE NINTH CIRCUIT

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ALVA G. BLANCHARD,

*Appellant,*

*vs.*

L. PINKERTON, INC., a corporation, and J. L.  
PINKERTON,

*Appellees.*

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APPELLEES' BRIEF.

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## APPELLEES' BRIEF.

---

### Statement of the Case.

This case involves the alleged infringement of Patents 2,233,395 and 2,199,611 owned by the Plaintiff-Appellant herein. These patents will hereinafter be referred to as the '395 patent and the '611 patent, respectively.

The trial court found that in view of the prior art each of the patents in suit should be strictly construed, and that, as so construed, the patents were valid but not infringed. The Complaint was therefore dismissed and that portion of Defendant-Appellees' counterclaim praying for invalidity of the patents was also dismissed.

The '395 patent of which only claim 1 is now in issue, (the appeal having been withdrawn as to claims 2 and 3 hereof), issued on an application filed by Appellant on October 14, 1935. The trial court found that all of the claims of the '395 patent must be specifically limited to the fuel valve assembly described in the patent and to the check valve 79 which is an essential part thereof.

The Court further found that the Appellee Pinkerton had, more than two years prior to the filing of Appellant's

earliest application, manufactured and sold fuel valve assemblies that, insofar as the claims of the '395 patent were concerned, were identical with the fuel valve assemblies alleged to infringe the '395 patent.

The application which matured into the '611 patent was a division of the application that became the '395 patent and was directed specifically to the needle valve assembly shown in the '395 patent. Claims 1, 2 and 5 which are the only ones in issue were found by the trial court to be limited to a single cross-pin operating a plurality of aligned needle valves, each of which has a slot in its valve stem, the slots being of different size and the valves being operated by a float lever.

Further with respect to the '611 patent the Court found that the accused devices did not have slots of different sizes in their valves, nor a single pin extending through slots in their valve stems, and that Appellees' means for operating the valves were not the equivalent of the structure recited in the '611 claims, but on the contrary were "entirely dissimilar from those shown in the '611 patent."

The principal contentions of the Appellant as set forth in his Opening Brief are:

- (1) That because Appellees did not cross-appeal herein, this Court is precluded from considering the question of the validity of the patents in suit, and
- (2) That the trial court erred in not holding the patents in suit to be pioneer patents and therefore entitled to a sufficiently liberal construction as to include the accused devices within the scope of their claims.

Point (2) above, of course is an admission that unless the patents in suit *are* pioneer in character they *cannot* be interpreted broadly enough to be infringed by Appellees' structures.

## Summary of Argument.

### A.

#### No Cross Appeal Is Necessary in This Case to Raise the Issue of the Validity of the Patents in Suit.

I. Appellees are not attacking the judgment of the lower court, but seek merely to affirm that judgment on any grounds which will support it.

The rule is well settled in this circuit that the Appellate Court may affirm on a ground not assigned by the trial court. Appeals in equity bring up the whole case and the decree below should be sustained if it was right for any reason.

This Court has consistently held that a void patent cannot be infringed and that the Appellate Court should inquire into the validity of the patent in suit on an appeal from a decree below of non-infringement and validity.

II. The public interest requires that the question of validity should always be considered by the Appellate Court.

### B.

#### The Patents in Suit Cover Separate and Distinct Inventions and Cannot Be Combined to Vary Their Scope.

The Appellant in this case has two separate and distinct patents, one of which covers a particular fuel valve assembly and the other of which covers a particular needle valve assembly.

Throughout his Brief and particularly in his Point 1. Appellant in attempting to show that his patents are pioneers in the art, combines and commingles the disclosures of the two patents into an alleged invention not covered by either patent. The technique employed for

accomplishing this purpose is to interchangeably employ singulars and plurals when using the words "invention" and "patent", and to include in his "invention" everything disclosed in the specifications, whether claimed or not.

C.

The '395 Patent.

The claims of this patent are directed solely and specifically to the fuel valve 20 and its attached conduits shown in detail in Figure 6 of the patent drawings. All the rest of the disclosure in the patent drawings was either transferred to the '611 patent or abandoned.

Unless the '395 patent is strictly construed to include the check valve 79, it is clearly invalid. As so construed, it is not infringed since the Appellees admittedly do not have a check valve.

I. The Appellee Pinkerton in 1932 manufactured a fuel valve assembly identical with the structure accused under the '395 patent.

Appellees' fuel valve Exhibit E exemplifies the 1932 fuel valve manufactured by Pinkerton. The only difference between Exhibit E and the present fuel valves sold by Appellees is the location of the manual relief valve.

The manufacture and sale of the Appellees 1932 structure was fully proved by the testimony of unbiased witnesses and was clearly documented by drawings dated prior to Appellant's first date of invention.

II. Since Appellees accused fuel valve structure is identical with their 1932 structure, there can be no infringement of the '395 patent.

That which infringes if later, anticipates if earlier. Since the 1932 structure and the accused structure are the

same, and the former was prior to Appellant's first date of invention, there can be no infringement. If the Court were to find that the accused device came within Appellant's claims it would have to hold Appellant's patent invalid.

The Appellant attempts to circumvent this finding of the trial court by urging this Court to read into claim 1 of the '395 patent all of the unclaimed disclosure therein, and then to reverse the lower Court's finding that the claim is limited to the check valve 79.

III. Claim 1 of the '395 patent is invalid for want of novelty and invention over Parker No. 1,965,052 and is so limited thereby as not to be infringed.

The Parker patent discloses a complete boiler control apparatus including each and every element of Appellant's '395 patent. The elements of Parker are arranged in exactly the same relationship and perform the same function as Appellant's apparatus.

Appellant's only answer to the Parker patent is that the element in claim 1 "means for supplying fluid under pressure to the compartment" should be construed to include the plural needle valve and whistle assembly claimed in his '511 patent.

IV. Claim 1 of the '395 patent is anticipated by House No. 521,166 unless limited to check valve 79.

The file wrapper clearly shows that claim 1 of the '395 patent was allowed solely because the Appeal Board thought, based on misstatements in Appellant's Brief, that the claim included check valve 79 as an element thereof.

As claim 1 stands, each and every element thereof is clearly found in the House patent. If claim 1 is con-

strued as by the lower court to include the check valve 79, then there is no infringement since Appellees admittedly do not have a check valve.

V. The '395 patent is also invalid for lack of invention over the other prior art patents of record.

#### D.

##### The '611 Patent.

I. Unless strictly limited to the disclosure of the specification, the claims of the '611 patent are invalid.

Appellant's needle valve assembly is but a minor improvement over the Reliance High-Low alarm valves Appellant sold prior to making his alleged invention.

The three claims in suit all must be limited as found by the trial court to a plurality of aligned needle valves having slots in their ends with a single pin passing through all of said slots. If the '611 claims are expanded to include linkage operation of one of the valves such for example as employed by Appellees, the claims read squarely on the prior art patents.

##### II. The Appellees' 1932 structure.

In 1932, three years before Appellant's earliest date, the Appellee Pinkerton was manufacturing an alarm body including a float and a needle valve. When the float dropped and the valve opened, it blew a whistle and operated a fuel shut-off valve. This is exemplified in Appellee's Exhibit F.

##### III. Appellees' accused needle valve structure.

In producing the accused structure the Appellees merely added an extra needle valve to their 1932 structure as was well known in the old Reliance High-Low water alarm, and connected the second valve to the float arm by a conventional prior art linkage.

This construction of Appellees provides numerous advantages over that of the '611 patent and the apparatus is much less subject to failure.

IV. There is no infringement of the '611 patent.

As the trial court found, the claims of the '611 patent are limited to a single pin and a plurality of valves having slots all mounted on said pin. As the trial court further found, Appellees' structure is entirely different since Appellees employ a separate linkage to operate their second valve. Even without recourse to the prior art, there is no infringement of the '611 claims by the Appellees' needle valve structure.

V. Prior art patents pertinent to the '611 patent in suit.

The Baldwin patent shows a boiler control and safety system employing three aligned needle valves, two of which are sequentially operated when the water in the boiler gets too high. One of these valves blows a whistle and the other shuts off the feed water.

The needle valves of Baldwin are operated by linkage almost identical with that used by Appellees. Consequently, if Appellant's claims are expanded sufficiently to include the Appellees' needle valve structure, then they also read on Baldwin and are invalid.

The same is true of the Wright, Singleton, Humphrey and Wyatt patents, all of whom show lost motion linkages for operating a plurality of aligned needle valves by means of a float lever. In each instance, if Appellant's claims are expanded sufficiently to include the accused structure then they are invalid over any one of these prior patents.

## ARGUMENT.

### A.

#### No Cross-Appeal Is Necessary in This Case to Raise the Issue of the Validity of the Patents in Suit.

The Appellant in his statement of the case, and in his point 2 asserts that the validity of the patents in suit is not open to attack by Appellees herein because they did not file a cross-appeal. Various cases are cited as authority for Appellant's position, but an inspection of said cases shows that none of them is authority for Appellant's position.

As we will point out in the following discussion, the issue of validity in a patent case is always before the Appellate Court, and the Appellate Court not only can, but should, consider this issue.

1. Appellees Are Not Attacking the Judgment of the Lower Court, but Seek Merely to Affirm That Judgment on Any Grounds Which Will Support It.

The judgment of the Court below, insofar as it was favorable to the Appellees, dismissed the Complaint, and Appellees may support that part of the judgment which was favorable to them on any grounds urged below. This would be true, even though it involved an attack on the reasoning of the lower court or an insistence upon a matter overlooked or ignored by it.

In the case of *Stoody Company v. Mills Alloys, Inc.*, 67 F. 2d 807, 20 U. S. P. Q. 1 (C. C. A. 9, 1933), this Court said:

“It is not necessary that a judgment be affirmed for the precise reasons that seemed controlling to the



lower court. In *McCloskey vs. Pacific Coast Company*, 160 Fed. 795, 801, the late Judge Gilbert of this Court said:

‘But notwithstanding that the theory upon which the Court below awarded its injunction may have been erroneous, the injunction must not be disturbed if in the pleadings and proofs we may discover any tenable ground upon which it may be sustained. \* \* \*’”

The foregoing rule was later enunciated in the case of *L. McBrine, Ltd. v. Silverman*, 121 F. 2d 181, 50 U. S. P. Q. 272 (C. C. A. 9, 1941), which was subsequently cited, with approval in the case of *Peterson v. Coast Cigarette Vendors, Inc.*, 131 F. 2d 389, 55 U. S. P. Q. 333 (C. C. A. 9, 1942).

In the *Peterson* case the District Court, as here, decided that the claims should be narrowly construed, and as so construed, that they were not infringed. On appeal, judgment was affirmed, *but on the grounds that the claims in suit were invalid*, the Court speaking through Circuit Judge Wilbur stating:

“Our power to affirm on a ground not assigned by the trial court is of course well settled.” (Citing *McBrine v. Silverman*.)

In the case of *Oliver Sherwood Company v. Patterson Ballagh Corp.*, 95 F. 2d 70, 36 U. S. P. Q. 364 (C. C. A. 9, 1938), the trial court found the claims to be valid and not infringed. The Plaintiff appealed from the decision and the Appellee cross-appealed. The Court stated, however, that the Appellee could, without a cross-appeal, attack the validity of the patent in suit in the Appellate Court.

The rule of the *Oliver Sherwood* case was followed in the later case of *Marchus v. Druge*, 136 F. 2d 602, 58 U. S. P. Q. 43 (C. C. A. 9, 1943), where the trial court had been silent on the question of validity of the patent in suit and the Appellees had not cross-appealed. This Court speaking through Circuit Judge Stephens stated as follows:

“\* \* \* It has been declared in connection with similar problems that the Appellate Court is not restricted to the questions decided below, but may consider all material matters in issue. (Citing cases.) Our own Court by dictum has indicated its approval of the latter view in *Oliver Sherwood Company v. Patterson Ballagh Corp.*, *supra*, although in that case the trial court had held the patent valid but not infringed.

“We believe the better view gives the Appellate Court the right to investigate the question of invalidity, providing all of the evidence is before it, and where, as is true in this case, there is no conflict in the evidence upon the issues. We proceed to inquire into the validity of patent No. 1,892,435.”

In the case of *Willamette Hyster Company v. Pacific Car & Foundry Co.*, 122 F. 2d 492, 50 U. S. P. Q. 422 (C. C. A. 9), the trial court found all of the patents involved to be valid and non-infringed. Plaintiff appealed from the decree and the Defendant did not cross-appeal as to validity. The Appellate Court, there presented with exactly the same questions as in the case at bar, thoroughly

considered all aspects of the situation and stated as follows:

“Appellant contends that since no exception was taken by Appellee to the Master’s Finding that these patents were valid and since his report was approved by the trial court, their validity must be deemed admitted for the purpose of this appeal. It has indeed been held that under Equity Rule 66 an Appellant cannot attack the Master’s finding to which he has not seasonably objected prior to their approval by the trial court. (Citing cases.)

“Assuming that the law in this respect has not been changed by the new rules, we are of the opinion that these cases do not qualify the rule recognized by this Court in *Oliver Sherwood Company v. Patterson Ballagh Corp.* (C. C. A. 9), 95 F. (2d) 70, 36 U. S. P. Q. 364, in which we held that when the trial court had held patents valid but not infringed and Plaintiff appealed, the Defendant could upon such appeal and without cross-appeal, attack that portion of the findings and decree which held the patents valid. In the case at bar the judgment was for a dismissal. The Appellant in this case maintains contrary to the ruling of the lower court that its patents were infringed; but obviously the decree of the lower court was right if the patents were invalid, for a void patent cannot be infringed. In *Mills Novelty Company v. Monarch Tool & Manufacturing Company* (C. C. A. 6), 49 F. (2d) 37, 9 U. S. P. Q. 28, a patent infringement suit, the Court said: ‘Appellant (Plaintiff) insists we should consider only the questions which the District Court decided against it. This is not the rule.

Appeals in equity bring up the whole case (with certain inferences in favor of the decree below) and the decree below should be sustained if it was right for any reasons. (Citing cases.) We therefore hold that the validity of both the Walker and the Nourse and Wickes patents may properly be considered upon this appeal.' ”

2. **The Public Interest Requires That the Question of Validity Should Always Be Considered, Whether Raised by the Parties or Not.**

In the case of *Muncie Gear Works, Inc. v. Outboard Marine & Mfg. Company*, 315 U. S. 759, 62 Sup. Ct. 865 53 U. S. P. Q. 15, Mr. Justice Jackson, speaking for the Court, stated:

“We are not foreclosed from a decision under Section 4886 on the point by the obscurity of its presentation in the Courts below. \* \* \* To sustain the claims in question upon the established and admitted facts would require a plain disregard of the public interest sought to be safeguarded by the patent statutes, and so frequently present but so seldom adequately represented in patent litigation.

“We therefore hold that the claims in question are invalid under Section 4886 of the Revised Statutes and accordingly have no occasion to decide any other question in the case.”

It is believed that the law is well settled in this Circuit that appellees herein may raise before this Court the question of the validity of the patents in suit. Appellees both pleaded and argued invalidity in the trial court and are still convinced that the patents in suit should also have been held invalid by the court below.

B.

The Patents in Suit Describe and Claim Separate and Distinct Inventions and Cannot Be Combined to Vary Their Scope as Attempted by Appellant in His Point 1 and Elsewhere in His Brief.

Starting with his Point 1, Appellant throughout his Brief uses either the singular or the plural when speaking of invention and casually borrows disclosure from either of the patents in suit to support the validity or vary the scope of the other patent. This is highly improper and gives a false picture of *each* patent.

In his Point 1 Appellant by combining the subject matter *claimed* in each of his patents with what he *attempted* to claim in the '395 patent but which was finally rejected by the Patent Office, and by his careless or studiously casual interchange of singulars and plurals of the word invention, attempts to pose as a pioneer in the field.

But the facts are, that while Appellant started out in his '395 case to cover broadly the combination of first correcting the feed water, then blowing a whistle, and finally shutting off the fuel as the boiler water dropped, he wound up in his '395 patent with three narrow claims to his *fuel supply valve alone!* and in his '611 patent with narrow claims *specifically limited* to his precise structure.

All of the discussion in Appellant's Brief about the importance of warning the fireman *before* the boiler was shut down, has nothing whatsoever to do with this case because Appellant was not awarded any claims whatsoever covering that idea. All the Appellant was given by the Patent Office was:

- (1) His '395 patent which only covers a fuel valve assembly without regard to any whistle or any sequence of operations whatsoever, and

- (2) His '611 patent which only covers a particular assembly of three needle valves, without regard to where they are used or what apparatus they are used with.

The foregoing facts will be enlarged upon and amplified hereinafter in discussing the individual patents in suit. Suffice it to reiterate for the present, that Appellant does not have any patent coverage at all on what he alleges in his Point 1 to be a pioneer improvement and to entitle him to a so-called liberal construction.

### C.

#### The '395 Patent.

The claims of this patent are directed specifically to the fuel valve 20 and its related structure shown in detail in Figure 6 of the patent drawings. Insofar as the claims are concerned, and particularly claim 1, it is unnecessary to refer to any of the other drawings or any of the specification except that directed to Figure 6.

Figure 1 of the patent is illustrative of one typical boiler installation in which the fuel valve 20 may be installed with or without other protective means such as whistles, feed water controls, etc. As previously mentioned, Appellant *tried* to get claims to the broad combination shown in Figure 1, but they were all denied.

The claims to the needle valve mechanism shown in Figures 2, 3, 4, 7a and b and 8a and b, were rejected by the Patent Office as being for a different and separate invention, and were divided out to become the subject matter of the '611 patent. Claims to the feed water valve assembly shown in Figure 5 were rejected and not pursued further.

As the patent finally issued, the entire invention, if any, was disclosed in Figure 6 alone, to-wit: the fuel valve assembly 20 which the trial court found included the check valve 79 as an essential element thereof.

This is set forth in Finding No. 4 as follows:

“The claims of the '395 patent all describe and must be specifically limited to the fuel valve assembly described in the specification and depicted in the drawings. Claims 2 and 3 are by their terms limited to ‘non-return means to prevent back-flow of fluid from said compartment.’ The only ‘non-return means’ disclosed or contemplated in said patent is the check valve 79 seen in Figure 6, and the claims are limited thereto. Claim 1, although it does not specifically recite the non-return means of claims 2 and 3, must, in view of the specification and prior art be considered to include said check valve 79 by reference. As so limited said claims are valid.”

As *so limited* by the prior art the trial court found claim of the '395 patent to be valid but *not* infringed, because the accused fuel valve assembly does *not* have a check valve or any suggestion thereof. Even the Appellant admits this.

As will be apparent from the discussion of the prior patented art in a later section, claim 1 is clearly invalid over several prior patents unless it is limited to the check valve 79 as ruled by the trial court.

It is Appellees' further contention that even when so limited it is nevertheless invalid.

1. The Fuel Valve Assembly Manufactured by Appellee Pinkerton in 1932 Was Identical With the Structure Presently Accused Under the '395 Patent.

Since Finding No. 10 [R. 21] is a complete answer to Appellant's attack upon the Appellees' early fuel valve structure, referred to in Appellant's Brief as the "1932 structure," and hereinafter referred to as such, we quote the Finding herein in full.

10. "The evidence shows conclusively that in late 1932 or early 1933 the Defendant Pinkerton manufactured and installed on a lease of the Continental Oil Company at Seal Beach, California, the boiler alarm and fuel valve control structures shown in Defendants' Exhibits E, E1, E2, F, F1, F2, F3, F4 and O. The details of said structures are shown by said Exhibits and were fully identified through the testimony of Defendant Pinkerton and of disinterested witnesses Brown, Thornton and Dollarhide, all of whom took part in said installation at Seal Beach, the manufacture of said apparatus being conclusively shown by disinterested witnesses Harvill, Beck and Robson. The testimony of all of said witnesses in all respects is found to be clear, satisfying and convincing beyond any reasonable doubt. The dates on the drawings illustrating Exhibits E and F are found to have been fully proved."

The Appellee's fuel valve Exhibit E was made from the same patterns as the first valves made in 1932. This fuel valve is shown in the photograph E1 and in the large drawing Exhibit E2 completed by R. C. Beck on April 19, 1935, six months prior to Blanchard's filing date of October 14, 1935. A simple comparison of Exhibits E, E1 and E2 with Appellees' present valve as shown in Figure



of Exhibit 9, shows that all of the parts of these two valve assemblies are substantially the same.

Both valve assemblies comprise a cylinder with a piston herein connected by a rod to an ordinary valve in the fuel conduit. The fuel valve is held open by the outward thrust of a spring on the piston and when steam is admitted to the top of the cylinder the piston moves down and closes the fuel valve.

Exhibit E was installed with a relief valve in the pipe fitting leading out of the top of the cylinder, whereas in Appellees' present structure the relief valve is built into the top of the cylinder. The schematic drawing Exhibit H dated 7-1-35, three months before Appellant's earliest date, shows a relief valve up near the alarm body for relieving pressure on all lines at once, and the witnesses to the Continental installation all testified that there was a relief valve on said installation.

There is absolutely no difference so far as the issues of this case are concerned, between Appellees' 1932 fuel valve assembly and their present fuel valve assembly. The Appellant stresses in detail the various elements of the presently accused valve structure, but as the trial court found, the Appellees were manufacturing this structure in 1932, nearly three years prior to Appellant's first date of application. Appellant produced no evidence carrying his invention back of his filing date, and consequently is restricted thereto [Finding No. 2, R. 18]. Consequently the dates of Appellees' drawings Exhibits E2, F2, F3, F4 and H which were conclusively proved to have been in existence at the dates they bore, are prior to the earliest date of Appellant's invention.

(a) THE TESTIMONY PROVING THE MANUFACTURE  
OF APPELLEES' 1932 STRUCTURE.

Mr. Harvill, one of the outstanding industrialists of Southern California, testified [R. 150-168] that while he was superintendent of Master Equipment Company in 1932 they manufactured for Mr. Pinkerton a considerable number of alarm bodies identical to Exhibit F and fuel valve assemblies identical to Exhibit E, that Mr. Pinkerton discussed the design and use of these alarms and valves with him at length and that he assembled said valves and alarms prior to delivery to Mr. Pinkerton so as to check their operability.

Mr. Harvill further testified that since he had left Master Equipment Company about the middle of 1932, he knew the valve structures had to have been manufactured prior to that date.

Mr. George Robson, one of the mechanics at Master Equipment Company, corroborated Mr. Harvill's testimony, and stated unequivocally that while Mr. Harvill was superintendent at Master Equipment Company he, Robson, did machine work on parts which were identical with parts of Exhibits E and F [R. 177-180].

The testimony further showed that Mr. Harvill upon leaving Master Equipment Company opened his own shop and started doing work for Herberts Machinery Company in 1932, which fact was verified by Mr. R. C. Beck [R. 170-176] who went to work for Herberts Machinery Company on January 1st, 1932. Mr. Harvill identified each and every part of Exhibits E and F, stating that the castings were delivered to him and that his shop did all of

he machine work thereon and assembled and tested the same. Mr. Harvill's testimony was not refuted, and was further strengthened by his recollection that at the time of the March, 1933 earthquake he had had his own shop for quite some time.

Mr. Beck positively identified the drawings Exhibits E2, E2, F3 and F4 as having been made by him and dated on the dates they bear, all prior to Appellant's first proved date. Mr. Beck further testified that he made the drawings from completed parts given to him by Mr. Pinkerton, and that it took him quite some time to make the drawings because he worked on them in his spare time.

Mr. Pinkerton corroborated [R. 230-236] the testimony of Messrs. Beck, Harvill and Robson in each and every particular.

(b) PROOF OF THE CONTINENTAL INSTALLATION.

The fact that the Appellee Pinkerton installed one of his first boiler alarm and fuel valve assemblies at the Seal Beach lease of the Continental Oil Company some time prior to February 25th, 1933, was clear and convincing. The trial court after hearing the testimony of the various witnesses, viewing their demeanor and listening to their qualifications, saw that all of these witnesses were unbiased, reputable citizens who had worked for the same oil company for approximately twenty years. All of these witnesses testified that the installation of the Pinkerton alarm and fuel shut-off assembly at the Continental lease at Seal Beach was prior to the death of Mr. Frank Van

Slyke who was then superintendent. The date of Mr. Van Slyke's death is proved by the certified copy of the death certificate Exhibit G [R. 323].

Mr. Brown was construction foreman at the Seal Beach lease at the time of the installation, Mr. Thornton was Mr. Brown's assistant, and Mr. Dollarhide was the operator of the boilers on the lease. Each of these witnesses identified Exhibits E and F as being substantially identical with the alarm and fuel valve assembly installed at the Seal Beach lease. Each of these witnesses stated unequivocally that the apparatus installed at Seal Beach comprised a fuel shut-off valve operated by a piston to which steam was delivered when the boiler float went down. Messrs. Thornton and Dollarhide recalled that there was a bleed valve fitting in the top of the cylinder, while Mr. Brown could not recall specifically whether or not such a valve was installed by Mr. Pinkerton, but stated positively that if it wasn't put on by Pinkerton, then it was added by his own crew. All of these witnesses additionally fixed the date as prior to the March, 1933, earthquake.

Appellant seeks to minimize the testimony of these witnesses because they were hazy on some details. However, it is quite natural that witnesses fifteen years after the happening of an event should be hazy on some details, but as the trial court saw, these witnesses were not hazy on the essential features of the installation. The credibility of these witnesses was not impeached, and their testimony was straightforward, concise and to the point.

2. Since the Appellees Have Been Manufacturing and Selling the Accused Fuel Valve Assemblies or Substantially Identical Counterparts Thereof Since Prior to Appellant's Earliest Proved Date of Invention for the '395 Patent, There Can Be No Infringement of Said Patent by the Accused Fuel Valve Assemblies.

By reference to the trial court's opinion [R. 14, 15, 16] and Findings 10 and 11 [R. 21, 22] it is seen that Appellees' 1932 fuel valve structure, Exhibit E, was considered by the Court to negative the possibility of infringement of the '395 patent. The identity between the 1932 and the accused structures mentioned by the Court [R. 22] was stated to be "in so far as the claims of Blanchard's '395 patent are concerned."

In other words, the Court found that since the accused structure [or its equivalent, Exhibit E] had been made *before* the alleged invention date of Appellant, there could not as a matter of law and fact be any infringement of the '395 patent. This ruling was correct.

It is a familiar rule of patent law that, "That which infringes if later, anticipates if earlier." If the trial court had held with Appellant that Appellees' fuel valve assembly was an infringement of claim 1 of the '395 patent, it would also have had to hold claim 1 invalid under the above rule, since its identical counterpart Exhibit E had been manufactured and sold long prior to Appellant's first proved date of invention.

The 1932 alarm body, Exhibit F, while also proved, was merely considered to be part of the general prior art with respect to the '611 patent, and was not held by the Court, or even urged by Plaintiff as a complete bar to the infringement charge under the '611 patent, as was the fuel valve Exhibit E under the '395 patent.

However, the Appellant has devoted fourteen pages of his Brief to a discussion of the 1932 structures, not as regards the '395 patent, but as to the '611 patent.

Beginning at page 38 Appellant attacks the testimony itself, and then on page 49 starts talking about "*the* patented combination including the master control unit which caused the consecutive actuation of the whistle and fuel shut off valves."

Just *what* combination Appellant is referring to is not stated. The discussion comes under the general heading of the '611 patent, but sub-heading (4) on page 49 says that the 1932 structure could not achieve the results of the patents in suit and therefore could not limit the scope of any of the claims in issue (claims of which patent?— or both patents).

It is next stated that "The primary result achieved by the patents (plural) in suit was *the* new function (singular) of warning the boiler attendant *by a whistle* that if he didn't attend to the water supply the fuel would be shut off in a short period of time."

Here the Appellant is again *combining* all the disclosures, patented and unpatented in his *two* patents, all into one neat package to confuse the issues.

Then at the bottom of page 49 it is stated that "This delayed action is not possible in the asserted 1932 structure and is present in the accused device" etc., and so on for several more pages winding up with a twisted interpretation on page 52 of the trial court's opinion.

It is quite evident that the Appellant, realizing that the 1932 *fuel valve* assembly, Exhibit E, is a complete bar to a holding of infringement of the '395 patent, has delib-

erately sought to confuse the issue by arguing that because the 1932 *alarm body* (needle valve assembly) Exhibit F is not an anticipation of the '611 patent (it has never been urged as such by Appellees) that *neither* of the 1932 structures, Exhibits E or F, is pertinent to the case. However, on the face of it, the relevancy of Exhibit F to the '611 patent has nothing whatsoever to do with the relevancy of Exhibit E to the '395 patent.

We do not wish to belabor the point, but it is respectfully urged that this Court read pages 49 to 52 very carefully to get the full effect of Appellant's specious reasoning from a false premise to a conclusion favorable to his case, but directly contrary to the facts and law of the case.

**Claim 1 of the '395 Patent Is Invalid for Want of Novelty and Invention Over Parker No. 1,965,052 and Is Limited Thereby to the Check Valve 79 Shown in Figure 6 of the '395 Patent.**

Parker [R. 325] discloses a complete safety apparatus for steam boilers whereby as needed, feed water is supplied to the boiler, a whistle blows and the fuel is shut off, all responsive to lowering of water in the boiler. However, since claim 1 of the '395 patent deals solely with the Blanchard *fuel valve* assembly, we will only discuss this portion of Parker, since it is all that is material. It is to be noted, however, in passing, that Parker in addition to shutting off the fuel when the boiler water gets dangerously low, also shuts off the fuel if the pressure in the boiler becomes too high from any cause.

Parker shows a conventional steam boiler 1 having a gas burner 2 supplied by a fuel conduit 3 in which there is a valve 34 yieldingly held open by weight 35. The

fuel valve 34 is closed by an arm 33 which is connected to the piston rod of a piston 39 in cylinder 31.

A water column 8 is connected to the boiler 1 and has a float 47 mounted on the inner end of a lever 46. The outer end of lever 46 is connected to three vertical rods or links 49, 50 and 51 which operate steam valves to control the feed water pump, alarm whistle and fuel valve 34.

When the float 47 drops (see Fig. 1) the outer end 48 of its lever raises the link 41, thus opening valve 27, permitting steam to flow from the top of the water column 8 down through the vertical pipe 32 (at the right of column 8), horizontal pipe 25, valve 27, T 26 and check valve 30 to the upper end of cylinder 31. This forces the piston 39 downwardly against the yielding force of weight 35 to shut the fuel valve 34. The pressure on the piston 39 is subsequently released by the manually controlled relief valve or pet cock in the upper end of the fuel valve cylinder 31.

Parker also provides a check valve 29 at the top of his water column 8 so that when steam pressure becomes excessive the valve 29 opens to permit steam to flow down through the vertical pipe at the left of column 8 (see Fig. 1), directly to the cylinder 31 to shut the fuel valve 34.

It is thus seen that Parker provides two steam circuits for shutting off the fuel valve 34 in response to dangerous boiler conditions, one through check valve 29 and the other through check valve 30. In each instance the fluid in the fuel valve cylinder 31 is trapped and holds the fuel valve closed until the relief valve in the top of the cylinder 31 is manually opened.

It is thus seen that Parker discloses each and every element of Appellant's '395 patent if we adopt Appellant's



contention that diaphragms and pistons are equivalent in this art.

This complete anticipation is readily apparent if we outline claim 1 as follows, indicating by numbers from Parkers' drawings, where each element is found in the Parker patent.

CLAIM 1 ('395).

In a safety apparatus for boilers (Parker's general assembly)

- (a) a fuel supply conduit (fuel conduit 3)
- (b) a valve in said conduit (fuel valve 34)
- (c) means for yieldingly holding said valve open (weight 35)
- (d) a compartment (cylinder 31)
- (e) a diaphragm (piston 39 with its sealing ring is the full equivalent of Blanchard's diaphragm)
  - (1) a protective liquid for said diaphragm in said compartment (the water of condensation in the upper end of cylinder 31, formed as described in the Blanchard patent)
  - (2) connections between said diaphragm and valve (the piston rod extending downwardly from piston 39 to lever 33 connected to fuel valve 34)
- (f) means for supplying fluid under pressure to said compartment for flexing said diaphragm and moving said valve to closed position (the left-hand pipe without number in Fig. 1 of Parker leading from check valve 29 down to cylinder 31; and also pipes 22, 25, valve 27, T 26, check valve 30, to cylinder 31)

(g) and manually operable means for relieving the fluid pressure on said diaphragm (the pet cock without number in the upper end of Parker's cylinder 31).

It is thus seen that Parker alone shows *each and every* element of Blanchard's claim 1, the elements being arranged in exactly the same relationship and performing the same function in exactly the same way.

The only possible way to avoid having claim 1 anticipated by Parker is to hold that a piston is not the equivalent of a diaphragm. However, from the Appellees' standpoint it makes no difference which way the Court holds because if the Parker piston is not the equivalent of Blanchard's diaphragm, then Appellees' piston of course is likewise not the equivalent, and the claim is not infringed.

It is thus seen that claim 1 of the '395 patent is anticipated by Parker, even though limited to include the check valve 79 as construed by the trial court herein. It is submitted that the trial court in addition to holding claim 1 not infringed, should have also held this claim to be invalid over the Parker patent.

In an attempt to meet the complete showing of the Parker patent the Appellant has set up a straw man and then tried to knock him down.

The Appellant contends that the element in claim 1

“means for supplying fluid under pressure to the compartment”

should be construed to include the plural needle valve and whistle assembly shown but not claimed in his '395 patent and attempts to distinguish from Parker by stating that

Parker does not have this "master control unit" and therefore does not meet claim 1.

However, such tactics can avail the Appellant nothing, for as previously mentioned, there is no suggestion whatsoever in the claim that it was meant to cover any such master control unit (claimed in '611) and furthermore, claims to this concept of first having a whistle blow and then shutting off the fuel were consistently rejected by the Patent Office and the Appellant is barred by file wrapper estoppel from now urging such an interpretation of claim 1.

If, as the Appellant urges, diaphragms and pistons are equivalents of each other, then Parker fully anticipates his claim of the '395 patent.

Finding No. 7 [R. 20] states specifically that the "means for supplying fluid under pressure" is the conduit 25a shown in Figs. 1 and 6 of the '395 patent. To this, the Appellant asks this Court to add, not just a control valve, but a particular kind of valve, a whistle and all the equipment to operate them in a particular way. Such a request is improper on its face.

As the trial court said in its memorandum opinion, it is the claims that are infringed, not the specification. Claims to the broad idea of combining the fuel valve of the '395 patent with the needle valves of the '611 patent were denied to Appellant by the Patent Office as lacking novelty and invention. It would therefore be contrary to the law of this Circuit and every Circuit for this Court to now re-write the claims in either of these two patents to give to the Appellant a monopoly on what has been in the public domain since long prior to Appellant's entry into this art.

4. Claim 1 of the '395 Patent Is Anticipated by the Prior Patent to House No. 521,166 Unless Limited to the Check Valve 79 as Was Done by the Trial Court. As so Limited It Is Admittedly Not Infringed.

The patent to House [R. 331] was the principal reference relied upon by the Examiner in rejecting claim 14 of Blanchard's application which became claim 1 of his '395 patent. The Examiner consistently held that House fully met claim 14. That the Examiner was correct and the Appeal Board wrong in subsequently allowing claim 14 as claim 1 of the '395 patent is abundantly clear from an inspection of the file wrapper, since it is quite apparent therein that the Appeal Board was under a clear misapprehension of the facts pursuant to definitely misleading statements in Blanchard's appeal brief.

The House patent shows a conventional boiler provided with a water column R connected thereto. A slide valve U is operated by a float S so that as the float is lowered, the valve U opens a port V to the feed water pump to supply water to the boiler. If for any reason the water continues to drop, slide valve U opens the second port V', permitting steam to pass down through pipe V3 to a cylinder W'. A piston W with a spring W2 in cylinder W' yieldingly holds the fuel valve X normally open by means of a connecting rod and link.

Cylinder W' is also provided with a relief valve W3 similar in location and function to that of Blanchard. As in Blanchard the condensed steam will fill the left end of the cylinder W' back up into the line V3 for a substantial distance. Periodic opening of relief valve W3 is therefore necessary to draw off this water and when desired, valve W3 can be opened to release the pressure on the piston

and permit the spring to open the valve in the same manner as Blanchard.

The only difference between House and Blanchard is that whereas Blanchard provides small bleed vents up near his control valve, House left his relief valve W1 slightly open during operation for the same purpose. House does not mention a check valve *but neither does Blanchard in his claim 1*, and consequently, unless Blanchard is construed to include the check valve 79 as found by the trial court, his claim is anticipated by House. It is to be particularly noted that claim 14 (patent claim 1) at no time included a check valve or other non-return means.

However, in his Brief on the first appeal Blanchard stated on page 42 of the '395 file wrapper that his structure was superior to that of House because

“the *check valve* holds the closing fluid in the head of the fuel cut-off valve until it is re-set by hand by releasing the fluid through the relief valve 78.”

Later in the second appeal, Blanchard's attorney took advantage of the careless statement of the Examiner on appeal and stated with respect to claim 14 as follows:

“In Applicant's construction the valve when once closed will not be allowed to open again *due to the check valve 79* until the hand operated valve 78 is opened to relieve the pressure above the diaphragm. *This is included as an element in this claim.*”

From the Appeal Board's decision appearing at the bottom of page 92 of the file wrapper, it is obvious that the Board did not read claim 14, but relied upon Applicant's Brief which stated unequivocally that the check valve 79 was an element of said claim. The Appeal Board

obviously had in mind when it made its decision the representation of Blanchard that claim 14 was allowable because it had a check valve therein which was not shown in the House patent.

It is clear therefore, that unless claim 1 is limited as specifically found by the trial court, and as said by Blanchard on his appeal it was, to include check valve 79, it clearly reads on the prior patent to House just as it reads on the prior patent to Parker.

The pertinency of the House patent and the clear mistake of the Board of Appeals was argued before the trial court and formed the principal basis for Finding No. 4 which limits claim 1 to the check valve 79 and consequently renders it admittedly not infringed.

**5. The Blanchard '395 Patent Is Also Invalid for Lack of Invention Over the Other Prior Art Patents as Follows.**

SUTHERLAND [R. 335] shows a float controlled needle valve which when the boiler water is too high, opens to permit steam to pass through lines 33 and 32 into the cylinder 19 to move the piston 18 downwardly to close the normally open valve 10 in the feed water line. The piston of Sutherland is identical with that used by Appellees and is operated by a float controlled needle valve in the same manner as Appellees'. Claim 1 is clearly invalid on Sutherland in view of the conventional relief valves shown by House and Parker.

The HORRIDGE [R. 339] device has a piston 15 movable in a cylinder 20 and normally held in its upper position by spring 23 to maintain a steam valve 8 in open position. When the pressure in the line from the feed water

pump becomes excessive the piston is depressed, closing the valve and thereby shutting off the steam to the feed water pump. Here again we have an apparatus which is structurally the same as Appellees' accused fuel valve assembly except for the conventional relief valve of Parker and House.

With respect to Appellant's discussion of the Sutherland and Horridge patents, Appellant states that one of the allegedly distinguishing features between Blanchard and Sutherland and Horridge is that the reference patents do not have a "master control unit" to actuate a fuel shut-off valve *after the level of the water* in the boiler has receded from the point *where a whistle* alarm has been sounded. Here again, as he does all through his Brief, Appellant asks the Court to read *two needle valves and a whistle* into the single element,

"means for supplying fluid under pressure to said compartment."

Appellant is clearly estopped by his file wrapper from properly making such a request.

The patents to SPILLER [R. 343] and FERRARI [R. 347] are cited as further illustrations of piston operated valves similar to Appellees'. It is of course immaterial whether the valve is in a fuel line or in a steam line. Both of these valves are held normally open by springs and are closed by fluid forced against the piston head to move it and the valve downwardly.

With respect to Spiller it is to be noted that Appellant's principal defense is that Spiller has no

"means for supplying fluid under pressure to his cylinder"

because he does not have a *plurality of valves and a whistle*.

This *needle valve and whistle defense* is raised on almost all of the prior art patents and has as little pertinency to one as to another. Appellant cannot now seek an interpretation of claim 1 which makes it coextensive with previously cancelled claims.

The WILLIAMS [R. 355], FULTON [R. 359], DOBLE [R. 367] and STANLEY [R. 373] patents are cited to show *diaphragm operated valves for boiler control* which are practically identical with the valve assembly of Appellant. Williams shows each and every element of Blanchard's claim 1 except the manually operable relief valve. Fulton shows a diaphragm operated valve which is the full equivalent of the Blanchard valve, while Doble and Stanley show boiler control apparatuses which were primarily designed for the steam automobiles bearing the names of the respective inventors. Each of these latter patents shows all of the elements of claim 1 of Blanchard except the manual relief valve. While these patents do not anticipate, there certainly was no invention in the addition of a conventional relieve valve to their structures.

It is therefore submitted that claim 1 of the Blanchard '395 patent *is invalid for lack of invention* over any of the described patents, particularly if as urged by Plaintiff, we ignore the check valve.

#### SUMMARY OF DEFENSES AGAINST THE '395 PATENT:

From the foregoing it is seen that the Appellees have a number of defenses to the '395 patent, each complete within itself as follows:

1. The Appellees' present fuel valve assembly being identical with that manufactured by Appellees in



1932, more than three years prior to the Appellant's earliest date, cannot possibly infringe the Appellant's '395 patent. This defense is thoroughly documented by the drawings E2 and H, both dated prior to Appellant's first application date, and the undisputed testimony of Harvill, Robson, Brown, Thornton and Dolarheid, all of whom corroborated the testimony of Pinkerton, and all of whose testimony was deemed by the trial court to be clear and convincing beyond a reasonable doubt. If the '395 patent reads on Appellees' fuel valve assembly, then the patent is invalid under the rule that "That which infringes if later, anticipates if earlier," since Appellees' structure antedates Appellant's invention.

2. There can be no infringement of claim 1 of the '395 patent because in order to sustain its validity, it must be construed as done by the trial court, to include the check valve 79 which is totally lacking in the Appellees' device. If not so construed, then the claim is clearly invalid.
3. Even when construed as by the trial court, claim 1 is invalid over the Parker patent for lack of novelty and invention.
4. Claim 1 unless limited to a check valve is anticipated by House, and would have been rejected by the Appeal Board if it had not been misled by Appellant's Appeal Brief in the Patent Office.
5. Claim 1 is invalid for lack of invention over either Parker or House taken in connection with the other prior patents of record.

D.

The '611 Patent.

In urging that his '611 patent is a pioneer and therefore entitled to a broad range of equivalents, the Appellant again ignores the clear showings of the prior art, and ignores the specific finding of the lower court [Finding No. 13, R. 23] to the effect that:

“Each of the claims in suit calls for and is limited to a single cross-pin operating a plurality of aligned needle valves, each with a slot in its valve stem, the slots being of different size and the valves being operated by a float lever. Each of the claims must be strictly limited to the precise structure illustrated in the patent, and *as so limited* is valid.”

For example, Blanchard stipulated at the trial that the Reliance High-Low alarm valve assembly, Appellees' Exhibit A illustrated in the Reliance catalogue sheet Exhibit A1 [R. 313, 314] was well known prior to 1930. Appellant also testified that prior to making his alleged invention of the patent in suit he had sold Reliance valves for a number of years.

Even a cursory comparison of Appellant's structure in the '611 patent with the old Reliance High-Low alarm valve structure shows that Appellant's plug and needle valves are merely Chinese copies of the Reliance plug and needle valves, Exhibits A and A1. What Blanchard very evidently did after he left Reliance was to take the Reliance High-Low valve structure, throw away one float and hook the two valves on the same pin so that they would open sequentially in response to movement of the remaining float.

In original claim 1 of his application as filed, Appellant tried to claim broadly the idea of a plurality of valves

sequentially opened by movement of a float. However, this claim was rejected by the Patent Office and cancelled by Appellant who then amended to specify his particular structure comprising a plurality of aligned needle valves having slots of different sizes in their ends, *all mounted on the same pin*. Appellant is now estopped to try and expand these claims to include conventional lost motion linkages such as shown by the prior art and employed by the Appellees.

Realizing this, the Appellant in order to try and make his invention sound important, adds to it the whistle and fuel valve disclosed in his '395 patent, and then cries "pioneer invention."

**1. Unless Strictly Limited to the Disclosure of the Specification, the Claims of the '611 Patent Are Invalid.**

The Plaintiff is again clearly on the horns of a dilemma, for a construction of the '611 claims broad enough to find infringement herein causes the claims to read squarely on the prior art. Conversely, a construction of the claims limited to what the Patent Office obviously intended them to cover finds no infringement in the Appellees' device. Consequently the Appellant again shuts his eyes to the prior art and urges that he has a pioneer patent and therefore is entitled to a construction broad enough to include Appellees' device.

The three claims in suit all recite the same elements, the only differences between the claims being in the specific language used. Claim 1 is typical and can be conveniently set forth as follows:

(a, b, c) A housing, a plurality of outlet passages through said housing, a valve in each of said passages,

- (d) said valve *having slots of varying lengths in one end* to determine the order in which they are opened,
- (e) *a pin through said slots,*
- (f. g, h) operated by a lever fulcrumed within said housing, a float on the end of said lever, whereby said valves are opened one at a time in sequence responsive to the downward movement of said float.

A plurality of needle valves arranged in a row and operated in sequence by a float was old long prior to Appellant and the only possible novelty available in these claims is the idea of providing aligned slots of different lengths in the valves through which a single cross-pin passes to operate all of the valves *without using additional linkage.*

If the Appellant made any invention, which is extremely doubtful, it must reside in the specific pin and slot arrangement set forth in elements (d) and (e) above. This is clearly apparent from an inspection of the file wrapper of the '611 patent wherein it is seen that claim 1 as originally filed was not allowed until amended by inserting the limitation

“said valves *having slots of varying lengths in one end* to determine the order in which they are opened, *a pin through said slots*”

If the above language is given a normal interpretation, claim 1, and by the same token claims 2 and 5 of the '611 patent, may be valid, although clearly not infringed by Appellees' structure.

However, the Appellant in order to include the Appellees' valve mechanism in his claims has expanded the claims to the point where they also read on the prior art

and hence are invalid. This same broad construction was urged upon the trial court below but was not followed by the Court who instead adopted a limited construction for the claims and consequently held them valid but not infringed.

The judgment of the lower court can be affirmed upon the grounds given, or this Court may within its sound discretion, adopt Appellant's interpretation of the '611 claims and hold them invalid over the prior art.

The Appellant as usual is trying to have his cake and eat it too. When discussing the prior art he adopts a narrow construction for his claims in pointing out the minute differences between his structure and those that went before. However, in discussing the accused device and trying to show infringement thereof, the Appellant throws his previous interpretation to the winds and urges that he has a pioneer patent that covers all structures for accomplishing his alleged new result. This is contrary to fundamental law and logic. The Plaintiff must pick a single construction for his claims and stick to it.

As was clearly stated by Circuit Judge Stephens in the case of *Wire Tie Machinery Company v. Pacific Box Corp.* (C. C. A. 9), 107 F. 2d 54, 43 USPQ 128:

“Appellant cannot be permitted to construe his claims with reference to his drawings and specification in order to escape invalidity, and then in the next breath seek to disregard the drawings and the specifications in order to spell infringement.”

This same rule was stated in somewhat different language by the Seventh Circuit Court of Appeals in the case of *Emory Industries, Inc. v. Schumann* (C. C. A. 7), 111 F. 2d 209, 45 USPQ 12, wherein the Court said:

“It is impossible for us to allow the claims to be supported and made more definite and certain by reference to the specification for the purpose of upholding their validity, and at the same time eliminate the specification restrictions in order to include the Defendants as infringers.

“The decree is reversed with directions to dismiss the complaint.”

The foregoing cases accurately describe and condemn what the Appellant has done in this case.

## 2. The Appellees' 1932 Structure.

As has already been mentioned, the Reliance high-low water alarms were on the market long before either Appellant or Appellees herein entered the field of boiler water control. Since the Appellee Pinkerton was manufacturing and selling a float controlled boiler alarm and fuel shut-off prior to the advent of Appellant into the field, we shall first consider this early structure of Appellees as part of the prior art before we consider the Appellant's charges of infringement.

As the record shows, the Appellee Pinkerton after some twelve years in oil field work started his own business in 1927 manufacturing and selling boiler feed water regulators. These regulators are still being sold by Appellees.

In 1931 Mr. Pinkerton started to develop the alarm and fuel shut-off hereinbefore referred to as the 1932 structure. This apparatus consisted of two main parts, a fuel

shut-off valve exemplified by Exhibit E previously discussed in connection with the '395 patent, and an alarm body and needle valve assembly exemplified by Exhibit F in evidence.

This equipment comprising Exhibits E and F has been manufactured and sold continuously from 1932 to date, the first installation thereof being at the Seal Beach lease of the Continental Oil Company in the latter part of 1932 or the early part of 1933.

Exhibits F1 and F2 [R. 318, 319] are photographs of the 1932 alarm body, Exhibit F, and Exhibits F3, F4 and F5 [R. 320, 321, 322] are drawings thereof made in 1934 prior to Blanchard's earliest date in this case. The internal construction of Exhibit F is best shown in the drawing Exhibit O in evidence. [R. 462.]

Referring particularly to the photograph F2 and the drawings Exhibit O, the numeral 6 on the latter designates a cap or flange on top of the alarm body into which an apertured plug 13 is screwed which carries a needle valve 15. The cap 6 has two outlets leading to pipes 11 and 12 which go to an alarm whistle and fuel shut-off valve respectively. The needle valve 15 is pivotally connected by a pin 50 to a float lever arm 20 which is in turn fulcrumed on a stationary pin 24. The other end of the arm 20 is pivotally connected to a float 23.

When the water in the boiler is at normal level the needle valve 15 is closed, but when the water level drops, the needle valve opens as illustrated in Figure 11 of Ex-

hibit O, thus permitting steam to pass through the needle valve aperture and out through the pipes 11 and 12 to blow the whistle and operate the fuel shut-off valve Exhibit E.

This type of apparatus proved entirely satisfactory for low pressure boilers, particularly on leases where the operator might at times be a mile or so distant from the boilers. The main thing was to shut down the boiler before serious damage was done and notify the operator that the boiler had been shut down.

As the drilling of wells was carried to greater depths and higher pressures were demanded of the boilers, shut-downs became more objectionable and expensive and it was desirable to notify the fireman before the fuel was shut off so as to give him a chance to fix the trouble if possible. To meet this need the Appellee Pinkerton in 1937, prior to the sale of any of Appellant's alarms in California, modified his 1932 structure to delay the action of the fuel shut-off valve until after the alarm whistle had blown.

This he accomplished by adding another needle valve in the manner taught by Reliance [R. 313] and connecting this additional needle valve to his float lever by a conventional lost motion linkage, many types of which are shown in the prior art patents to be later discussed.

As the trial court found [Finding 20, R. 24],

“the accused devices are merely normal variations of the Reliance valve and the early Pinkerton structure, open to any member of the general public.”



### 3. Appellees' Accused Needle Valve Structure.

The Appellees' accused structure is best shown in Exhibit D [R. 315] wherein it is seen that the device comprises a flange 6 provided with fluid passages 8 and 9 having valve seats 13 therein. A valve 15 slidable in passage 8 is pivotally connected at its rear end by means of a pin 50 to the end of float arm 20 which is operated by a float 33. This much of the present structure is *exactly the same* as in the 1932 apparatus. The parts are the same and the operation is the same—when the float goes down the valve 15 is pulled rearwardly from its seat, permitting steam to pass through the passage 8 and out through the pipe 11 to blow an alarm whistle.

A second valve 16, slidable in passage 9, has a loose link in the form of a ring 52 pivotally attached to its rear end by a pin 51, the ring being pivotally connected by a pin 24 to the flange body.

A pin 60 on lever 20 is positioned so that it extends through ring 52 a little above the middle thereof when the valve 16 is fully closed as seen in Figs. 1 and 2 of Exhibit D.

As the float drops to the position shown in Figs. 3 and 4, the valve 15 is first opened and as the pin 60 moves downwardly it engages the lower portion of ring 52, moving it downwardly about its pivot point 24, thus pulling the valve 16 off its seat and permitting steam to pass out through the passage 9 and pipe 12. When water is introduced into the chamber and the float rises, the steam pressure closes the valves.

As Mr. Pinkerton testified [R. 253, 254], and as apparent from the exhibits, there are many advantages to this type of structure over the type of construction illustrated

in the '611 patent. By using an extra lost motion link it is possible to very loosely fit all parts and thereby minimize binding or freezing from corrosion, whereas, when a single pin is passed through slots in all of the valve stems as in Blanchard, it is necessary to more accurately adjust the parts and corrosion or scaling of one valve stem renders the entire device inoperative. By employing a conventional lost motion linkage the Appellees secure freedom of movement not possible in the Blanchard structure.

4. There Is No Infringement of the '611 Patent.

The single feature of novelty of the '611 patent is set forth in the claims in issue as follows:

Claim 1—“said valves *having slots* of varying lengths *in one end* to determine the order in which they are opened, *a pin through said slots* operated by a lever fulcrumed within said housing,”

Claim 2—“*a cross-pin* on said lever, *stems* on said valves *having openings therein to receive said cross-pin* said valve stem openings being of varying lengths,”

Claim 5—“*a pin* carried by said lever, *stems* on said valves *having openings therein through which said pin extends*, the opening in each stem being of different lengths from the others.”

Unless the above elements of the Blanchard claims can be found in the Pinkerton structure there can be no infringement unless a broad application is made of the doctrine of equivalents. As will be seen later, no expansion of the claims is possible without making them read on numerous prior patents and therefore invalid.

Examining the claims it will be seen that each of them speaks of “a pin.” The claims do not speak of “pins” in the plural, and the specification does not show “pins” in the plural. The '611 patent shows only the concept of passing the *same* pin through the aligned slots of a plurality of valves arranged side by side.

Furthermore, it is noted that the slots are all specified as being *in the valves or valve stems*. That the Appellant and Examiner intended exactly this structure and no more is evidenced from the fact that in claim 2 the pin is mentioned a second time as “*said cross-pin*” and in claim 5 it is mentioned the second time as “*said pin*.”

Appellant concedes that Appellees do not have slots of different size in their valve stems and that they do not have a common pin extending through slots in said valves or stems. Appellant attempts to get around this obvious distinction by saying that Appellees' separate ring 52 and separate pin 60 are equivalents of the claimed structure. However, since similar linkages used for the same purpose are shown in the prior art, the claims become invalid if construed as requested by Appellant.

Appellant's claim in this regard that Appellees are merely duplicating his parts is untenable because by using a linkage of several parts instead of Appellant's structure, the Appellees are doing what was taught by the prior art long before Blanchard entered the field.

The trial court was correct when it found that “the Defendants' structures uses *separate* pins located at *two different places* to operate two *separate* valves in a manner different from that disclosed and claimed in said '611 patent”; that the pin and ring lost motion mechanism of Appellees was “entirely dissimilar from those shown in the '611 patent.” [R. 24.]

The pin 60 in Exhibit D does not engage any portion of the valve stem 16, but on the contrary, engages and operates an entirely separate and distinct link 52 which is in turn pivotally connected to the valve 16.

It is true that Appellees' device accomplishes the same result as that accomplished by Appellant, but it is equally true that this result is accomplished by an *entirely different* structure in an *entirely different* way.

It is submitted that even without regard to the prior art there could be no infringement of the '611 claims by the Appellees' structure.

Additionally, when we consider Appellees' own 1932 structure and the Reliance valve which were part of the prior art and the various plural valves and lost motion mechanisms for boiler control shown in the prior art patents now to be discussed, it becomes further evident that the findings of the trial court were correct and should be sustained.

#### 5. The Prior Art Patents Pertinent to the '611 Patent.

BALDWIN No. 796,982 [R. 389]:

Referring to Fig. 1 of Baldwin it is seen that he has a water column C connected to a steam boiler, an alarm whistle G mounted thereon, and a steam line I and fitting 1<sup>1</sup> running to a feed water supply valve B.

Referring to Fig. 4, it is seen that Baldwin has a housing or plug mounted in the side of his water column C which is provided with three passages, in each of which is located a needle valve. The upper two valves C19 and C22 operate the whistle G while the lower valve C3 operates the feed water pump valve B.

The valve C3 has a slot C6 in its stem in which a pin C8, carried by the float lever C1-C4, slides to open valve C3 when the float C rises. The upper valves C19 and C22 are connected to the float lever by a lost motion pin and slot linkage. As the float rises, it first opens needle valve C3 and then opens needle valve C19.

We see therefore that as in Appellees' structure, the first valve to be opened is direct-connected to the float lever, and the second valve to be opened is operated by a separate link and pin arrangement similar to that used by Appellees. Consequently, if we construe the '611 claims as urged by the appellant so as to include the ring and pin linkage of Appellees, the claims are invalid as reading squarely on the Baldwin structure.

In the five pages that Appellant devotes to Baldwin in his Brief, he seeks to distinguish Baldwin by reason of the fact that the Baldwin needle valves operate sequentially upon *upward* movement of the float lever rather than *downward* movement thereof. However, this is an immaterial functional difference and the Appellant would be the first to claim that his patent would not be avoided by turning his structure upside down.

The other point urged by Appellant is that in Baldwin the second valve operates the whistle instead of the first valve. However, this argument is of no avail because there is nothing in the claims of the '611 patent about whistles, fuel shut-off valves, feed water valves, or any other apparatus to be operated by the claimed needle valve assembly. The claims do not even recite that the apparatus is for use in a boiler, and certainly there is no suggestion in any of the claims as to what the various outlet passages are connected to.

Again we have the Appellant setting up a straw man so that he will have something to knock down when discussing the prior art. The Appellant asks this Court to read into the '611 claims a large part of the disclosure of the '395 patent so that he can find some differences between the '611 claims and the prior art. The Appellant has gone even farther here than he did on the '395 patent since the elements he wishes the Court to read into the '611 claims are not even disclosed in the '611 patent.

The plain and simple fact of the matter is that if we construe these claims broadly enough to be infringed, they read fairly and squarely upon the Baldwin patent, which if turned upside down is exactly the Pinkerton structure insofar as the Appellant's claims are concerned. The only way that the '611 patent can be held valid is by limiting it as was done by the trial court.

WRIGHT No. 668,302 [R. 399]:

This patent shows a housing having a central float chamber  $a^1$ , an inlet port  $a^7$  and an outlet duct  $a^8$ . A valve housing  $e$  is screwed into and depends from the cover  $c$  of the chamber and has three aligned passages therein provided with needle valves,  $f$ ,  $g$  and  $h$  having stems  $f^1$ ,  $g^1$  and  $h^1$  respectively. The valve stems are connected at their lower ends to links or levers  $f^2$ ,  $g^2$  and  $h^2$ , respectively, all of which levers are pivotally mounted on a pin  $M$  in a manner similar to the Reliance valve Exhibit A.

A float  $b$  has a slotted stem  $b^1$  extending downwardly therefrom which is provided with three pins  $b^3$ ,  $b^5$ , and  $b^7$ . The center lever or link  $f^2$  is connected by a slot in its free end to pin  $b^3$  on the float stem  $b^1$  while the levers  $f^2$  and  $g^2$  are positioned to be engaged by the pins  $b^7$  and  $b^5$ , respectively (see Fig. 3). The needle valves are

normally closed and as the float rises it first opens center valve f and then valves g and h sequentially as their levers are engaged by their respective pins on the float stem.

If we adopt Plaintiff's theory that the valve stems can be in two or more parts, and that the respective valves can be operated by separate pins as is done by Appellees, we find that Wright is a complete anticipation of the Blanchard '611 patent. As a matter of fact, if we merely cut off one of Wright's levers f<sup>2</sup>, g<sup>2</sup> or h<sup>2</sup> and put a pin on the remaining lever, we would have the Pinkerton structure exactly.

Since the Wright patent was a file wrapper reference over which Blanchard's claims were allowed it is obvious that the Examiner was not interpreting the Blanchard claims in the manner now contended for by Appellant. It would seem self-evident that the Examiner having the Wright patent in front of him while considering the Blanchard claims, must have taken the Blanchard claims at their face value and assumed that when Blanchard said "slots in said valve stems" and "a pin through said slots" he meant just that, to-wit, that his claims thus distinguished over the art which had separate pins operating separate valves through intermediate linkages in the manner used by Pinkerton.

On page 37 of his Brief Appellant purports to state four reasons why his '611 patent represents an advance over Wright, but analyzing these paragraphs numbered 1 to 4 we see that they are just different statements of one point, to-wit, that according to Appellant, Wright does not have a plurality of outlet passages as called for in the claim. The only justification given for this novel

theory is that because all of these passages open into a single large outlet pipe that they are not passages. On the face of it, Wright provides three separate passages, valve seats and needle valves in exactly the same way that Appellant provides them. Nothing whatsoever is said in the Blanchard claims indicating whether or not the separate passages lead to separate devices or any devices. For Appellant to argue that they do, is a plain admission that Wright meets all the other elements of his claims.

The fact remains, that if the '611 claims are expanded sufficiently to include the Appellees' structure, then by that same interpretation they read on Wright as well as Baldwin.

SINGLETON No. 7,767 [R. 409]:

This patent is an excellent illustration of the antiquity of Appellant's idea of sequentially opening several needle valves in response to continuous movement by a float in a boiler. In some respects the Singleton patent is much closer to the Appellant's structure than those previously discussed.

Singleton shows a valve box C having three passages therethrough in each of which a needle valve is located. These needle valves are aligned horizontally in exactly the same manner as Blanchard's. The center needle valve G<sup>1</sup> has an enlarged slot S in its stem and the outer needle valves G are provided with heads g on their stems. The slotted stem of center valve G<sup>1</sup> has a small upstanding lug 3 thereon.

A float D is connected to a lever L which is pivoted at its other end to a pin f and is provided with a pin L<sup>1</sup>



which extends up through the slot S. The stem of valve  $G^1$  is also provided with horizontal pins  $e^1$  adapted to engage the valve heads  $g$ .

When the float D drops, the float lever L moves downwardly, causing its pin  $L^1$  to rotate to the right about pin  $f$  in Fig. 1, thus engaging the lug  $e$  and pulling the valve  $G^1$  to open position. Further downward movement of the float and its arm L causes the pins  $e^1$  to engage the heads  $g$  on the valves  $G$ , thus causing these valves to open.

It is thus seen that Singleton provides a multiple valve structural for boiler control comprising a housing having three passages therein, each provided with a needle valve exactly as in the Blanchard structure. One of the valves (the center one) has a slot *in its valve stem* which is engaged by pin  $L^1$  to open the valve  $G^1$ . Lost motion mechanism in the form of heads  $g$  and pins  $e^1$  cause the valves  $G$  to be opened after the first valve has been opened.

Here again we find an old prior art structure which is almost a duplicate of the Appellees' structure herein. Consequently, if the Appellant's '611 claims are to be expanded sufficiently to include the Appellees' structure, then of necessity they must also include and read upon the Singleton structure and therefore be invalid.

This patent has not been discussed by Appellant in his Brief before this Court, but in his Brief below the Appellant urged the same fallacious reasoning as previously discussed with respect to the Wright patent, to-wit, that Singleton does not show a plurality of outlet passages. This is erroneous on its face, since Singleton of course has three separate passages and each one is an outlet from the boiler. Furthermore, as previously mentioned, there is nothing in the Blanchard claims that says anything

about where the passages must lead. This patent, along with the patents to Humphrey and Wyatt were urged upon the trial court and were considered by the Court and mentioned in its opinion. Appellant therefore had notice that Appellee would urge these patents in this proceeding.

HUMPHREY No. 796,516 [R. 413]:

This patent is a file wrapper reference and if the Appellant's claims are given a normal interpretation they are not anticipated by Humphrey. However, if the claims are expanded as requested by Appellant, they also read on Humphrey and are therefore invalid.

Referring to Figs. 1 and 2 of Humphrey it is seen that like Blanchard he provides three needle valves in horizontal alignment which are sequentially opened by movement of a float. Each of the needle valves K is provided with a stem M, said stems being provided with downwardly extending arms k, o and p, respectively, which are referred to in the specification as vertical levers. These levers are all pivoted on a bracket P so that as the levers are rotated about P they will consecutively open the needle valves. The float arm j is securely fastened to the center lever k so that the center valve K is immediately responsive to movement of the float in the same manner as one of the valves of Blanchard.

The float arm j is also provided with a pair of loops, a small loop l and a large loop m which encircle the valve levers o and p, respectively. The loops being of different size, movement of the float arm j will cause the loops to successively engage their respective levers so that after the center valve k is opened further movement of the float sequentially opens the other valves.

Either one of the loops of Humphrey is the full equivalent of the ring 52 of Pinkerton and the levers k, o and p are the full equivalent of Pinkerton's pin. In other words, if the '611 claims are construed to include a first valve direct connected to a float lever, and a second valve indirectly connected thereto by a pin and link as urged by Appellant, then the claims read on Humphrey as well as on Pinkerton.

WYATT No. 105,289 [R. 419]:

This patent also shows the antiquity of delayed action mechanisms for sequentially opening a pair of valves operated by a float and lever. As the float F drops it rotates lever c' which has an extension d thereon which engages valve C, pushing it to the left to open it. Further downward movement of the float F causes pin h carried by the float lever to open slide valve H, thus permitting steam to flow to the pipe G to blow a whistle. The opening of the first valve passes steam to the feed water pump.

There being nothing in the Blanchard claims about whether his valves are pulled or pushed open, or where or to what his valve passages lead, or what they are supposed to operate, we see again a prior art patent which anticipates the Blanchard claims unless they are limited to his particular pin and slot arrangement as done by the trial court.

SUMMARY WITH RESPECT TO THE '611 PATENT:

From a consideration of the prior art as exemplified by the Reliance high-low water alarm, the Appellees' old 1932 structure and the prior patents to Baldwin, Wright, Singleton, Humphrey and Wyatt, it is readily apparent that there is more than ample evidence in the record of this

case to sustain the findings of the lower court that the Appellees' structure is not the equivalent of Appellant's and that the Appellant's structure must be limited in view of the prior art to his specific construction of a single pin through a plurality of slots in the stem of the aligned needle valves.

There is also abundant evidence in the record that if the claims of the '611 patent are not so limited, then they are anticipated by the prior art references.

It is Appellees' position additionally that even giving the claims the benefit of the narrow interpretation placed upon them by the trial court, that the claims although not void for lack of novelty, are void for want of invention over the prior art.

It is not seen how the Appellant's contribution to the old art of sequentially operating a plurality of needle valves can rise to the dignity of invention in view of the many and varied previous mechanisms in the public domain for this purpose.

While it is true that the mere affirmance of the lower court's decision upon the grounds expressed by the lower court will dispose of this case as between the parties, it is believed that patents of this type should not, as a matter of public policy be allowed to remain at large to plague other workers in the art who are entitled to make reasonable variations in the prior art devices in the public domain.

It is submitted therefore that in addition to holding the '611 claims not to be infringed, this Court should hold them invalid for lack of invention.

E.

**Conclusion.**

The judgment of the trial court dismissing the complaint herein should be affirmed:

1. On the ground of non-infringement, and
2. On the ground of invalidity of both patents in suit.

Respectfully submitted,

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## APPENDIX.

### Points and Authorities.

#### LAW POINT 1.

The Claims Measure the Invention.

(a) “\* \* \* the claims measure the invention. They may be explained and illustrated by the description. They cannot be enlarged by it.”

*Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U. S. 405, 419.

(b) “The scope of every patent is limited to the invention described in the claims contained in it, read in the light of the specification. These so mark where the progress claimed by the patent begins and where it ends that they have been aptly likened to the description in a deed, which sets the bounds to the grant which it contains. It is to the claims of every patent, therefore, that we must turn when we are seeking to determine what the invention is, the exclusive use of which is given to the inventor by the grant provided for by the statute.”

*Motion Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U. S. 502, 510.

(c) “In view of the statute, the practice of the Patent Office, and the decisions of this Court, we think that the scope of Letters Patent should be limited to the invention covered by the claim, and that though the claim may be illustrated, it cannot be enlarged by the language, used in other parts of the specification.”

*Railroad Co. v. Mellon*, 104 U. S. 112, 118.

(d) "The claim is the measure of his right to relief, and while the specification may be referred to to limit the claim, it can never be made available to expand it."

*McClein v. Ortmyer*, 141 U. S. 419, 432, quoted with approval in *Rip Van Winkle Wall Bed Co. v. Murphy Wall Bed Co.*, 1 F. 2d 573, 679 (C. C. A. 9).

## LAW POINT 2.

The Claims Must Be Definite, Unambiguous and Read on the Patentee's Own Structure.

(a) "The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms."

*White v. Dunbar*, 119 U. S. 47, 51-52.

(b) "The developed and improved condition of the patent law, and of the principles which govern the exclusive rights conferred by it leaves no excuse for ambiguous language or vague descriptions. The public should not be deprived of rights supposed to belong to it, without being clearly told what it is that limits these rights. The genius of the inventor should not be restrained by vague and indefinite descriptions of claims in existing patents, from the salutary and necessary right of improving on that which has already been invented. It seems to us that nothing can be more just and fair, both to the patentee and to the public, than that the former should understand, and correctly describe, just what he has invented, and for what he claims a patent."

*Merrill v. Yeomans*, 94 U. S. 568, 573-74.



(c) "All claims are required to be definite, so that the public may know what they are prohibited from doing during the term of the patent, and what they are to have at the end of the term, as a consideration for the grant. *Brooks v. Fiske*, 15 How. (56 U. S. 1), 212, 214-15;"

*Walker on Pats.*, Deller's Ed. 1233, 4.

(d) "The statutory requirements relevant to particularity in the descriptions and claims of Letters Patent are conditions precedent to the authority of the Commissioner of Patents to issue such documents, and if such document is issued, the description or claims in which do not conform to these requirements, then that document is void."

*Walker on Pats.*, Deller's Ed. 1273.

(e) "The object of the patent law in requiring the patentee to 'particularly point out and distinctly claim the part, improvement or combination which he claims as his invention or discovery,' is not only to secure to him all to which he is entitled, but to apprise the public of what is still open to them."

*Rip Van Winkle Wall Bed Co. v. Murphy Wall Bed Co.*, 1 F. 2d 673, 679 (C. C. A. 9),

quoting with approval from:

*McClain v. Ortmyer*, 141 U. S. 419, 423.

### LAW POINT 3.

The Courts Should Not *Change* the Meaning or Scope of Claims by Reading Elements Into Them.

(a) "Some persons seem to suppose that a claim in a patent is like a nose of wax which may be turned and twisted in any direction, by merely referring to the specifi-

cation, so as to make it include something more than or something different from, what its words express. The context may, undoubtedly, be resorted to, and often is resorted to, for the purpose of better understanding the meaning of the claim; but not for the purpose of changing it and making it different from what it is. The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms. This has been so often expressed in the opinions of this Court that it is unnecessary to pursue the subject further.”

*White v. Dunbar*, 119 U. S. 47, 51.

(b) “Since the inventor must particularly specify and point out the part, improvement or combination which he claims as his own invention or discovery, the specification and drawings are usually looked at only for the purpose of better understanding the meaning of the claim, and certainly not for the purpose of changing it and making it different from what it is.”

*Howe Machine Co. v. National Needle Co.*, 134 U. S. 388, 394.

(c) “While this may be done with a view of showing the connection in which a device is used, and proving that it is an operative device, we know of no principle of law which would authorize us to read into a claim an element which is not present, for the purpose of making out a case of novelty or infringement. The difficulty is that if we once begin to include elements not mentioned in the

claim in order to limit such claim and avoid a defense of anticipation, we should never know where to stop.”

*McCarty v. Lehigh Valley Railroad Co.*, 160 U. S. 110, 116.

(d) “We should have no warrant for limiting the claims by the elements of the disclosure which they do not include, even if the elements were new. A patentee who claims broadly must prove broadly; he may not claim broadly, and recede as he later finds that the art unknown to him has limited his invention. That is the chance he must take in making broad claims; if he has claimed more than he was entitled to, the statute does give him a *locus poenitentiae*, but he must seasonably disclaim the broad claims *in toto*. He may not keep them by interpretative limitation; he must procure new claims by reissue. This is the significance of *Milcor Steel Co. v. George A. Fuller Co.*, 316 U. S. 143 (53 USPQ 268).”

*Foxboro Co. v. Taylor Instrument Co.*, 157 F. 2d 226 (70 USPQ 338, 343).

(e) “It (Appellant) urges upon us the application of the rule that claims must be read and construed in the light of the specification and so liberally interpreted as to uphold and not destroy the right of the inventor in the substance of his invention. *Westinghouse E. & M. Co. v. Quackenbush*, 53 F. 2d 632 (11 U. S. P. Q. 44) (C. C. A. 6), and cases therein cited. We are of the opinion that the rule there applied is limited to claims that are ambiguous and so require construction, and is in no event applicable where it appears to be clear that the inventor sought a broader monopoly than would seem to be justified by his invention as he has described it.”

*Aluminum Co. of America v. Thompson Products, Inc.*, 122 F. 2d 796 (51 U. S. P. Q. 237, 239).

LAW POINT 4.

To Be Equivalent, a Device Must Perform the Same Function in Substantially the Same Way.

(a) "One thing, to be the equivalent of another, must perform the same function as that other. *Machine Co. v. Murphy*, 97 U. S. 120, 125 (1878); *Rozwell v. Lindsay*, 113 U. S. 97, 103 (1885); *Roller Mill Patent*, 156 U. S. 261 (1895)."

*Walker on Pats.*, Deller's Ed. 1704.

(b) "The fact that one thing performs the same function as another, though necessary, is not sufficient to make it an equivalent thereof. *Eames v. Godfrey*, 1 Wallace (68 U. S.) 78 (1864); *Westinghouse v. Boyden Power-Brake Co.*, 170 U. S. 537, 569 (1898)."

*Walker on Pats.*, Deller's Ed. 1706.

(c) "Function must be performed in substantially the same way by an alleged equivalent, as by the thing of which it is alleged to be an equivalent, in order to constitute it such. *Burr v. Duryee*, 1 Wall. (68 U. S.) 531, 573; *Forncrook v. Root*, 127 U. S. 176, 181 (1888)."

*Walker on Pats.*, Deller's Ed. 1706.

(d) "But, after all, even if the patent for a machine be a pioneer, the alleged infringer must have done something more than reach the same result. He must have reached it by substantially the same or similar means, or the rule that the function of a machine cannot be patented is of no practical value. \* \* \* 'That two machines

produce the same effect will not justify the assertion that they are substantially the same, or that the devices used by one are therefore mere equivalents for those of the other.’”

*Boyden Power-Brake Co. v. Westinghouse*, 170 U. S. 537, 568, 569.

(e) “If an invention is only a trifling step forward and the claims speak plainly, they preclude resort to the doctrine of equivalents as regards alleged infringement. *Deitel v. Unique Specialty Corporation*, 54 F. (2d) 359, CCA 2 (1931).”

*Walker on Pats.*, Deller’s Ed. 1240.

#### LAW POINT 5.

Unless Invention Is Present the Patent Is Invalid.

(a) “Under the statute, (R. S. 4886) the device must not only be ‘new and useful,’ it must also be an ‘invention’ or ‘discovery.’”

*Cuno Eng. Corp. v. Automatic Devices Corp.*, 314 U. S. 84, 90; 51 USPQ 272, 275.

(b) “Since *Hotchkiss v. Greenwood*, 11 How. 248, 267, decided in 1851, it has been recognized that if an improvement is to obtain the privileged position of a patent, more ingenuity must be involved than the work of a mechanic skilled in the art.”

*R. G. LeTourneau, Inc. v. Gar Wood Industries, Inc.*, 151 F. 2d 432; 67 USPQ 165 (CCA 9).

(c) “In *Smith v. Nichols*, 88 U. S. 112, 119, the Court said:

‘But a mere carrying forward or new and more extended application of the original thought, a change only in form, proportions, or degree, the substitution of equivalents doing substantially the same thing in the same way by substantially the same means with better results, is not such invention as will sustain a patent.’

\* \* \* Accordingly, the flared construction is not such invention as will sustain a patent.”

*Wilson-Western Sporting Goods Co. v. Barnhart*,  
81 F. 2d 108; 28 USPQ 125 (CCA 9).

(d) “In the case of *Klein v. City of Seattle*, 77 Fed. 200, 204, this Court said:

‘A patent must combine utility, novelty, and invention. It may in fact embrace utility and novelty in a high degree, and still be only the result of mechanical skill as distinguished from invention \* \* \* It is not enough that a thing shall be new \* \* \* and that it shall be useful, but it must under the Constitution and statute, amount to an invention or discovery.’

The principles stated in these decisions are well settled and require no further discussion.”

*Keszthelyi v. Doheny Stone Drill Co.*, 59 F. 2d 3;  
13 USPQ 427 (CCA 9).

(e) “In *Grinnel Machine Co. v. Johnson Co.*, 247 U. S. 426, 432, the Supreme Court stated:

‘No one by bringing together several old devices without producing a new and useful result, the joint product of the elements of the combination and something more than an aggregate of old results, can acquire a right to prevent others from using the same devices singly or in combination.’

All of the elements of the patent in suit were present in the prior art and combining these elements to make the patented device did not involve invention.”

*Eagle, et al. v. P. & C. Hand Forged Tool Co.*,  
74 F. 2d 918; 24 USPQ 181 (CCA 9).

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